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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/018,609 | 02/11/2002 | Ernst Rytz | 01-732 | 5092 |
| 7590 | 06/30/2004 | | EXAMINER | |
| Bachman & LaPointe Suite 1201 900 Chapel Street New Haven, CT 06510-2802 | | | ASHLEY, BOYER DOLINGER | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3724 | |

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/018,609 | RYTZ ET AL. | |
| | Examiner Boyer D. Ashley | Art Unit 3724 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 2/11/02 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

1. Applicant's preliminary amendment amending claims 3, 5, 6, and 8 has been.

Election/Restrictions

2. Applicant's election with traverse of Group II in the reply filed on 3/24/04 is acknowledged. It should be noted that even though the examiner is not completely convinced by applicant's arguments the restriction requirement is henceforth withdrawn.

Priority

3. Acknowledgement is made of applicant's claim for foreign priority of German document 19929163.2 dated 6/25/1999.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "four compensation cylinders" (claim 2) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement

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sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because it contains legal phraseology as well as being in claim format. Correction is required. See MPEP § 608.01(b).

Claim Objections

7. Claims 1-8 are objected to because of the following informalities:

In claim 1, the phrase "An apparatus for the fine blanking of workpieces" should be "an apparatus for fine blanking of workpieces" because it appears that there is no clear anticipate basis for "the fine blanking". Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, there are two transitional phrases rendering the claim confusing, in that, it is not clear if the "comprising" language on line 2 or the "characterized in that" language on line 7 is to be considered the transitional. Therefore, it is not clear if the where the body of the claim beings, i.e., it is unclear if the press plate, punch and etc. are part of the body of the claim or not.

It should be noted that, although reference characters enclosed by parenthesis in claims are not improper they do not serve to distinguish the claim invention from the prior art. However, it appears that the use of a term in parenthesis, e.g. "(ejector)" raises a slightly different concern, in that, it is not clear what, if any, weight should be attached to the expression. For the purposes of this office action, the term "(ejector)" will not be considered as any limiting recitation in the claims. Applicant is respectfully requested to removed the expression from the claim or positively recite the element as a limitation. If applicant believes such an expression is improper applicant is requested

to explain to the examiner how and in any event the examiner will not consider any expressions enclosed by parenthesis as limiting.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated Gardner, U.S. Patent 5,749,279.

Gardner discloses the same invention as claimed including: a compensation cylinder (26 or 46/48) capable of supporting a ram, wherein the cylinder is hydraulically connected to an opposed cylinder (26 or 46/48, see Figure 4).

It should be noted that the V-ring guide has not been positively recited in the claims and therefore, not part of the invention. Hence, the phrase "the V-ring cylinder" only refers to the cylinder upon which the punch is connected. Moreover, it should be noted that the expression "V-ring cylinder" does not imply any structure other than that of cylinder because the V-ring portion of the expression refers only to the punch guide not the cylinder, that is, it only is used to denote the cylinder not to describe any specific structure of the cylinder. Therefore, Gardner clearly discloses the referenced cylinder in the claims.

As to claim 3, the device of Gardner clearly discloses in Figures 1 and 2 that the cylinders (46/48/26) all include pistons (54) firmly connected to the ram by piston rods (58).

As to claim 5, the device of Gardner discloses a cylinder arranged on a crosshead (see Figure 1).

As to claim 6, the device of Gardner discloses the use of a main cylinder (e.g., 42).

As to claim 7, the effective cross-sectional area of main cylinder (42) is clearly shown as greater than that of the compensation cylinders (e.g. 46/48).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner in view of Ejima et al., U.S. Patent 5,673,601.

Gardner discloses the invention substantially as claimed except for the use of four compensation cylinder; however, Gardner and Ejima et al. both disclose that it is old and well known in the art use to use multiple compensation cylinders for the purpose of reducing noise and inaccurate punchings. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use four compensation cylinders with the device of Gardner in order to increase the effects of the

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single cylinder. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use four compensation cylinders with the device of Gardner in order more effectively control noise, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

14. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner.

Gardner discloses the invention substantially as claimed except for the effective cross-sectional area of the compensation pistons being equal to an effective cross-sectional area of the piston of V-ring cylinder; however, at the time the invention was, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use similar effective cross-sectional areas for both the compensation piston and the v-ring cylinder in order to more accurately control the movements of the cylinders because applicant has not disclosed that the effective cross-sectional areas provide any advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with either effective cross-sectional areas taught by Gardner and the claimed equal effective cross-sectional areas because both effective cross-sectional areas perform the same function of accurately controlling the movements of both the punch and die. Therefore, it would have been an obvious matter of design choice to modify Gardner to obtain the invention of claim 4.

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardner in view of Ejima et al., U.S. Patent 5,673,601.

Gardner discloses the use of logic valves because applicant has not disclosed any specific definition for the "logic" valves and all hydraulic cylinder valves are designed to be "logical" in that they separate control the amount of hydraulic fluid flowing through the valves.

In the alternative, even if it is argued that Gardner lacks the logic valves, Ejima et al. discloses that it is old and well known in the art use to valves that are controllable by a control for the purpose of maintaining the desired pressures in the cylinders. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use "logic" valves with the device of Gardner in order to accurate control the pressure in the cylinders.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Boyer D. Ashley
Primary Examiner
Art Unit 3724

BDA
June 28, 2004